

This Page Is Inserted by IFW Operations
and is not a part of the Official Record

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images may include (but are not limited to):

- BLACK BORDERS
- TEXT CUT OFF AT TOP, BOTTOM OR SIDES
- FADED TEXT
- ILLEGIBLE TEXT
- SKEWED/SLANTED IMAGES
- COLORED PHOTOS
- BLACK OR VERY BLACK AND WHITE DARK PHOTOS
- GRAY SCALE DOCUMENTS

IMAGES ARE BEST AVAILABLE COPY.

**As rescanning documents *will not* correct images,
please do not report the images to the
Image Problem Mailbox.**



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/294,760 04/19/99 HICKMAN

F H&S1P002.A

EXAMINER

TM02/0924

PAUL L. HICKMAN
POST OFFICE BOX 1823
LOS ALTOS CA 94023-1823

HICKMAN, M
ART UNIT PAPER NUMBER

2161
DATE MAILED:

09/24/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.		Applicant(s)	
	09/294,760		HICKMAN ET AL.	
	Examiner		Art Unit	
	Marianne Huseman		2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 8, 10 - 14 and 18 - 24 is/are pending in the application.
- 4a) Of the above claim(s) 21 - 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 8, 10 - 14 and 18 - 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s) <u>6</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-20, drawn to a method and means for monitoring multiple electronic mail accounts, classified in class 705, subclass 1.
- II. Claims 21-24, drawn to database structure, classified in class 707, subclass 100.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as the particulars of a database structure that is unrelated to monitoring electronic mail.

See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

2. During a telephone conversation with Mr. Paul Hickman on September 8, 2001 a provisional election was made without traverse to prosecute the invention of monitoring multiple electronic mail accounts, claims 1-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 21-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Specification

4. The disclosure is objected to because of the following informalities: Cross-references to related applications and Patents should be inserted on the first page of Applicants' disclosure. See 37 CFR 1.78 and MPEP § 201.11.

Appropriate correction is required.

5. The amendment filed 12/22/99 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: communicating via a WAN.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

There is no mention of communicating via a WAN, anywhere in the specification.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, line 4, there is no proper antecedent basis for "the designation ... of e-mail accounts". This also applies to line 6.

In claim 2, line 6, "system" should probably be deleted.

In claim 10, line 4, after "e-mail", - - account - - should probably be inserted.

In claim 12, line 14, after "consolidator", - - for - - should be inserted.

In claim 12, line 16, it is not clear as to what is meant by "developing data", i.e., how is the data developed?

In claim 20, line 1, "29" should probably be - -19 - -.

In claim 20, line 2, it is not clear as to what is meant by "inputter", as this term is not found in Webster's dictionary. Also, if a keyboard is considered to be an "inputter" (as disclosed on page 8, lines 33-34), how is a keyboard "stored in said storage medium" (line 2)?

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1, 2, 8, 10 -13, and 18 – 20 are rejected under the judicially created doctrine of double patenting over claims 1, 9 – 11 and 16 – 18 of U. S. Patent No. 5,956,486 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

11. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: all of the method steps and means of the present application are claimed in the U.S. Patent, with the exception of WAN; claim 14, of the present application (see also, paragraph 6, above). Further, the claims of the present application differ from those of the U.S. Patent only in that they are broader in scope.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1, 2, 8, 10 – 14 and 18 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson et al in view of Cooper et al (please note that Cooper et

Art Unit: 2161

al, Patent Number 6,052,442, is a continuation of Application 08/554,744, filed on November 7, 1995).

Thompson et al teach an apparatus for automatically polling message service systems such that Applicants' monitoring of multiple accounts reads on figures 8 and 12 and column 12, lines 8 – 63, wherein a user may specify a polling routine. One such routine is described as being based on a time interval, i.e., at specific time intervals the user's computer begins the polling of various systems, implying that the use of an MWL is not necessary. See column 7, lines 17 – 29 and the Abstract, lines 5 – 8.

Also, although Thompson et al do not specifically teach polling plural e-mail accounts, but rather a voice-mail account and an e-mail account, Thompson et al do teach that changes to their Administration routine, figure 12, can be made. More specifically, changes (see column 12, lines 19 – 21) in the services to be polled are taught wherein a user could conceivably add different e-mail accounts to those services already being polled.

Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention for Thompson et al to poll as many e-mail accounts as desired as the system described in Thompson et al already polls at least a single e-mail account and the difference between one account and many is simply a matter of adding condition diamonds (as well as the corresponding program code) to figure 8 (i.e., element 808, 808a, 808b... each corresponding to a different e-mail account) and then transferring control to figure 9 for each additional e-mail account or condition diamond. This addition of condition diamonds is considered to be obvious to anyone who can program a computer.

Also, while Thompson et al's system is taught in a PBX environment, Cooper et al teaches a similar polling apparatus which operates in an internet environment. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time to expand the system of Thompson et al to include operation in the internet environment as is taught by Cooper et al if a wider range of communication is desired.

Regarding claim 2: Applicants' access information reads on element 1205 of figure 12 and column 12, lines 49 – 55.

Regarding claim 8: Applicants' step of storing reads on elements 208 or 206.

Regarding claims 10, 11 and 20: Applicants' step of displaying reads on element 110 and columns 12 and 13, lines 64 – 68 and lines 1 – 30, respectively.

Regarding claim 13: Applicants' LAN reads on column 3, lines 37 – 40.

Conclusion


14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Moon et al, although filed in 1997, claims polling a plurality of e-mail accounts.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne Huseman whose telephone number is 703-605-4277. The examiner can normally be reached on Monday - Friday, 6:30 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-9051 for regular communications and 703-305-9051 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9700.


JAMES H. TRAMMELL
SUPERVISOR, PATENT EXAMINER
TECHNOLOGY CENTER 2100


Marianne Huseman
Examiner
Art Unit 2161

mh
September 20, 2001